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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,664	12/03/2001	Thomas C. Hoegemeyer	N1258-004	7581

32905 7590 03/09/2004

JONDLE & ASSOCIATES P.C.
9085 EAST MINERAL CIRCLE
SUITE 200
CENTENNIAL, CO 80112

EXAMINER

FOX, DAVID T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,664

Applicant(s)

HOEGEMEYER, THOMAS C.

Examiner

David T. Fox

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/17/03
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 10 and 12 is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7, 8, 11 and 13-16 is/are rejected.
- 7) ☒ Claim(s) 2, 3 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant's amendment of 17 December 2003 has overcome the outstanding rejections under 35 USC 112, second paragraph, except as indicated below; the rejection under 35 USC 102/103 over Podol'skaya (1982); the art rejection of claims 11 and 14 over Miller; and the outstanding obviousness rejection over claims 2-3, 6, 9-10 and 12-13.

Claims 15-16 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, as stated on page 2 of the last Office action.

Applicant's arguments filed 17 December 2003 have been fully considered but they are not persuasive.

Applicant urges that the amendment to delete "F1" obviates the rejection. However, as these claims depend upon claim 1, they are still drawn to hybrid seed which by definition is 100% outcrossed. On page 3 of the specification, lines 22-25, and on page 6, lines 19-23, Applicant states that the aim of the present invention is to minimize "contamination or pollination" from "outside pollen sources, such as nearby corn fields". If intended, amendment of line 1 of claims 15-16 to re-insert ---F1--- before "seed", and amendment of line 2 of claims 15-16 to delete "outcross" and to insert the following phrase after "seed", would obviate this rejection:

---produced by contamination or pollination from nearby corn fields---

Claims 5 and 8 remain rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's admitted state of the prior art, as stated on page 3 of the last Office action.

Claims 5, 7 and 8 remain rejected under 35 U.S.C. 102(b) as being anticipated by each of Podol'skaya et al (1988) and Sevov, as stated on page 3 of the last Office action.

Applicant's arguments filed 17 December 2003 have been fully considered but they are not persuasive.

Applicant urges that the amendment to exclude popcorn overcomes the above rejections. However, claim 5 also recites "or, alternatively, non-sweetcorn", which thus reads on popcorn. Deletion of the phrase above would obviate the particular art rejections above, but would result in the re-instatement of the rejection of claim 8 under 35 USC 102/103 over Podol'skaya et al (1982) as set forth on pages 4-5 of the last Office action.

Claims 8, 11 and 14 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of Nelson and Kermicle et al, as stated on pages 4-5 of the last Office action.

Applicant's arguments filed 17 December 2003 have been fully considered but they are not persuasive.

Applicant urges that the art rejections above are improper, given the actual teaching by Nelson of corn races which are homozygous rather than heterozygous for the GaS allele, the failure of Kermicle et al to teach an elite corn inbred, and the amendment of the claims to recite elite corn inbreds.

The Examiner maintains that Nelson teaches that "some races" were "GaS/-" , i.e., had only one copy of the GaS allele and were therefore heterozygous. See page 501, first full paragraph, lines 8-9. Regarding Kermicle et al, the Examiner maintains that further evidence is needed that W22 is not an elite corn inbred. Applicant's assertion of same is not probative. The specification broadly defines "elite" as "commercially grown" or "commercially sold" (see page 4, lines 20-23). Furthermore, it is noted that claim 8 has not been amended to recite "elite" corn seed.

Claim 13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Miller, as stated for claims 11 and 14 on pages 5-6 of the last Office action.

The Examiner acknowledges Applicant's amendment of claims 11 and 14 to recite the presence of at least one GaS allele. However, claim 13 recites corn seed produced by selfing a corn plant which is heterozygous for the GaS allele. Due to Mendelian segregation, one-fourth of the progeny of this selfing will not contain the GaS allele, and will thus be indistinguishable from the inbred corn plant taught by Miller. Amendment of claim 13 to specify that the seed contains at least one GaS allele would obviate this rejection.

Claims 1, 4-5, 7-8, 11 and 13-16 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Podol'skaya (1982) taken with each of Nelson, Podol'skaya (1988) and Sevov, as stated on pages 6-7 of the last Office action for claims 1-16.

Applicant's arguments filed 17 December 2003, insofar as they pertain to the claims above, have been fully considered but they are not persuasive.

Applicant urges that Podol'skaya (1982) does not teach the incorporation of the GaS allele into elite yellow field corn genotypes. However, the claims above do not recite this limitation. In view of Applicant's arguments, and in view of the past recalcitrance of elite yellow field corn genotypes to the introgression of the GaS allele unless accompanied with sterility or other deleterious effects on other agronomic traits due to linkage drag, as stated on page 2 of the specification, bottom paragraph, it is now considered that the combination of references above fails to provide a reasonable expectation of successful introgression of the GaS allele into elite yellow field corn varieties.

See *In re Lindner*, 173 USPQ 356 (CCPA 1972) and *In re Grasselli*, 218 USPQ 769 (Fed. Cir. 1983) which teach that the evidence of nonobviousness should be commensurate with the scope of the claims.

Claims 2-3, 6, 9-10 and 12 are deemed free of the prior art for the reasons above.

Claims 2-3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 9-10 and 12 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (571) 272-0795. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (571) 272-0804. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

February 27, 2004

DAVID T. FOX
PRIMARY EXAMINER
GROUP 180

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